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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 20

Application Number: 09/159,509

Filing Date: 9/23/98

Appellant(s): Browning et al.

Robert C. Kowert
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 10/4/01.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because appellants have failed to point out why claims 10-46, 48-94, and 97-108 are separately patentable (see 37 CFR 1.192 (c7)).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

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(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Appellants' claims 1-46, 48-94, and 97-108 are rejected under 35 U.S.C. 251.

First, appellants' claims 1-46, 48,94, and 97-108 have a defective reissue oath.

Appellants assert that the reissue declaration properly states errors by which the patentees claimed less than they had a right to claim in the original patent, that the errors arose without deceptive intent, that their new claims do not represent impermissible recapture of surrendered subject matter, and therefore, that claims 1-9 should be allowable. It is the examiner's contention that the errors cited in appellants' declaration which were corrected by preliminary amendment to the specification (paper no. 6, filed 4/26/99) were merely typographical errors suitable to a Certificate of Correction, and appellants' new claims represent impermissible recapture of surrendered subject matter. Accordingly, the examiner has rejected claims 1-9 as having a defective, reissue declaration.

Next, claims 10-46, 48-94, and 97-108 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the

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patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that appellant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application. Appellants' independent claims 10, 46, 58, 69, 84, and 102, as well as their dependent claims, are an attempt to recapture subject matter of claims 1-9 which were deliberately amended (i.e. canceled) by appellants following a rejection by the examiner.

(11) Response to Argument

To make clear the extent of appellants' attempt to recapture the examiner makes reference to pages 7 through 14 of paper no. 13, filed by appellants on 2/21/01. In those pages appellants present the language of claims 1 and 8 of the patent (5,559,995) clearly showing the language added to the claims to overcome the relevant prior art and comparing that language with the language of their newly-amended, independent claims 46, 69, 84, 97, and 102. Since appellants' claims rise and fall together because appellants failed to point out why claims 31-94 are separately patentable, the examiner will discuss claims 1 and 69 as

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presented in paper no. 13 on pages 8 and 9. Claim 1 was amended to recite "grouping means...for grouping said first and second virtual objects in the virtual world into a grouped object comprising said first and second virtual objects joined at an intersection of the first and second edges, the grouped object represented by at least one of a three-dimensional and rotatable wireframe object and a three-dimensional and rotatable sweep polygon" to overcome the prior art. This limitation was omitted from claim 69 and its dependents. In arguing for the patentability of claim 1 of the patented application (07/939,834) on page 7, line 21 through page 8, line 2 of paper no. 22 (filed on 4/2/96) of the application, appellants stated:

Claim 1 positively recites a "grouping means...for grouping said first and second virtual objects in the virtual world into a grouped object comprising said first and second virtual objects joined at an intersection of the first and second edges, the grouped object represented by at least one of a three-dimensional and rotatable wireframe object and a three-dimensional and rotatable sweep polygon." However, Wexelblat does not disclose such a grouping means.

In the same application on page 9, lines 11-15, of paper no. 22 they further state on behalf of the application's claim 7 which is current claim 8:

In response to the rejection of claim 7 under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103 as being obvious over Wexelblat, Applicants respectfully submit that claim 7 is patentable for at least the same reasons set forth for the patentability of claim 1.

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That same, limiting language defining grouping means as presented in independent claim 1 and in their arguments (page 7, line 21 through page 8, line 2 of paper no. 22) and argued as defining over Wexelblat is also present in claim 7 but is either absent from all of appellants new claims or has been specifically broadened for the purpose of recapture.

In section 1412.02 of the MPEP under the heading “CRITERIA FOR DETERMINING THAT SUBJECT MATTER HAS BEEN SURRENDERED”, it states:

If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists.

The language cited was presented/stated and specifically argued as making the previously rejected claims allowable over the prior art of record. Omission of such language from all of appellants' claims or broadening of such a limitation constitutes recapture.

In seeking to overcome the examiner's rejection of their claims 10-46, 48-94, and 97-108 under 35 U.S.C. 251 and the recapture rule, appellants first argue the examiner has failed to state a *prima facie* rejection for each claim according to the recapture rule. As noted in Section (7), *supra*, appellants have failed to point out why each of claims 10-46, 48-94, and 97-108 are separately patentable resulting in all of the claims standing or falling together. However, an examination of the preceding paragraphs in this Section (11) dealing with appellants' omission or dilution of the limitation related to “grouping means...for grouping

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said first and second virtual objects in the virtual world into a grouped object comprising said first and second virtual objects joined at an intersection of the first and second edges, the grouped object represented by at least one of a three-dimensional and rotatable wireframe object and a three-dimensional and rotatable sweep polygon", which was specifically argued by appellants as overcoming the examiner's rejection when seeking their original patent should make clear why all of appellants' new claims constitute recapture.

Appellants next sought to argue "it was the 'three-dimensional' group limitation that was added after the final rejection that secured allowance of the claims" ignoring the specific recitation of the grouping language (as noted by the examiner, *supra*) which incorporates the "three-dimensional" group limitation as merely one aspect of the totality of the language appellants' chose in their original arguments in paper no. 22 to argue as that which defines over the prior art.

After more obfuscating arguments appellants finally dealt with the limiting language which they knowingly deleted from their claims or diluted after arguing it constituted what made their invention patentable over the prior art. They first argued in relation to this language that it "was not relied upon to distinguish from the prior art." This ignored appellants' arguments to the contrary during the prosecution of the application (page 7, line 27)

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through page 8, line 2 of paper no. 22 (filed on 4/2/96) cited by the examiner, *supra*.

Second, they argued that “Even if the limitation were considered material, the recapture rule would still not apply because the reissue application claims are materially narrower than the surrendered claim in regard to the ‘grouping’ claim element by inclusion of the ‘three-dimensional’ group limitation.” This once again ignored the fact that the “three-dimensional” group limitation was already a component of the totality of the language argued by the appellants during prosecution as defining over the prior art. Appellants could have chosen to merely recite the term, three-dimensional, or similar limited language and argue it as the defining language, but they did not. Having argued the totality of the language defined over the prior art during the prosecution, it is not now appellants’ option to selectively delete portions of the language they chose and argued. Finally, appellants argued there was “similar language” in some of the new claims. Though no specific claims were referenced, “similar language” is merely broadened language in appellants’ claims when one closely inspects it.

In summary, appellants argued in page 7, line 21 through page 8, line 2 of paper no. 22:

Claim 1 positively recites a “grouping means...for grouping said first and second virtual objects in the virtual world into a grouped object comprising said first and second virtual objects joined at an intersection of the first and second edges, the grouped object represented by at least one of a three-dimensional and rotatable

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wireframe object and a three-dimensional and rotatable sweep polygon.” However, Wexelblat does not disclose such a grouping means.

In the same application on page 9, lines 11-15, of paper no. 22 they further state on behalf of the application’s claim 7 which is current claim 8:

In response to the rejection of claim 7 under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103 as being obvious over Wexelblat, Applicants respectfully submit that claim 7 is patentable for at least the same reasons set forth for the patentability of claim 1.

The examiner agreed Wexelblat did not teach such a “grouping means” as defined by the totality of the language appellants chose to cite and argue as defining over the art (i.e., “Wexelblat does not disclose such a grouping means.”) Therefore, the examiner allowed the application.

Now, based on spurious arguments which ignore appellants’ arguments during the original prosecution or selectively recall them in a biased manner, appellants seek to recapture in new claims 10-46, 48-94, and 97-108 that which has already been surrendered during the original prosecution. They are barred from doing so as explained by the examiner in this section (11), *supra*. Therefore, claims 10-46, 48-94, and 97-108 stand rejected under 35 U.S.C. 251, and as a consequence, claims 1-9 stand rejected under 35 U.S.C. 251 because of a defective declaration since all of appellants’ new claims represent improper recapture, and

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the only other errors identified in appellants' declaration were mere typographical errors suitable to a Certificate of Correction.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



WMT
March 25, 2002

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